IN THE

Supreme Court of the United States

October Term, 1901. *No.*

JOHN A. BRILL AND THE J. G. BRILL COMPANY,
Petitioners,

vs.

THE PECKHAM MOTOR TRUCK AND WHEEL COMPANY, *et al.*,
Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

To the Honorable the Justices of the Supreme Court of the United States:

Your petitioners, John A. Brill and the J. G. Brill Company, respectfully show to your Honors as follows:

1. On or about October 15, 1900, the petitioners filed their bill of complaint in equity in the Circuit Court of the United States for the Southern District of New York, against the Peckham Motor Truck and Wheel Company *et al.*, the respondents herein, alleging the infringement of letters patent of the United States, No. 478,218, for electric street railway car

trucks, dated July 5, 1892, issued to George Martin Brill, the title to which had become vested in the complainants therein.

2. On October 26, 1900, your petitioners, the complainants in the said bill in equity, made a motion before the said Circuit Court for a preliminary injunction. The complainants' injunction affidavits were served about ten days before said motion was argued; the defendants' affidavits were filed at bar on the day the motion was argued, and had not previously been served on the complainants. The complainants *were not permitted, under the rules of practice of the said Court, to file counter-affidavits* relating to new matter set up in defendants' affidavits.

3. The bill averred, and the injunction affidavits established, that a previous suit upon the *same letters patent* (*Brill* vs. *Third Avenue Railroad Company*) had been decided (July 9, 1900) by Judge Shipman in the Circuit Court for the Southern District of New York, in which he *sustained the validity* of the patent here in suit and of claims 1, 2, 9, 10, 11, 12, 14 and 27 thereof. (Reported in 103 Fed. Rep. 289.)

4. Upon consideration the said Circuit Court in the present proceedings ordered a preliminary injunction to issue. In his opinion, filed December 3, 1900 (105 Fed. Rep. 626.) Judge Lacombe said:

> "The only question presented is whether defendant's structure *infringes*. That involves the construction of the claims declared on, and, for the purpose of this motion, the *construction already adopted by this court on final hearing* in the Third Avenue case should be followed; for there is no prior patent, no prior use, proved here which was not before Judge Shipman. It is true that in that case the defendant's device was a much

closer copy than the one now under consideration, containing, as it did, the feature that the spiral springs came first into play, and the further feature of depending caps, in which the leaves of the elliptic springs play vertically. But *the court most carefully indicates that the leading feature of the invention lies outside of these details.*

. . . . . .

"The combination which Judge Shipman describes as the *gist* of the invention *is undoubtedly in defendant's structure*, and, under well-settled rules of practice, complainant is entitled to a restraining order until final hearing."

At the same time Judge Lacombe entered an order directing that the operation of the said preliminary injunction should be suspended pending an appeal to the Circuit Court of Appeals *provided the same be taken in five days.*

5. An appeal was thereupon taken by the defendants in said proceedings, the respondents herein. The cause was heard by the Circuit Court of Appeals for the Second Circuit on March 13, 1901, and upon consideration an opinion was filed therein holding that the decree of the Circuit Court should be reversed, and the cause be remanded with a direction to the Circuit Court to dismiss the bill of complaint with costs. (Reported in 108 Fed. Rep. 267.) This was done upon the supposed authority of *Mast, Foos & Company* vs. *Stover Manfg Co.*, 177 U. S. 485.

6. Thereupon your petitioners, the complainants in the said cause, filed their petition in the said Circuit Court of Appeals, praying for a rehearing of the cause to the end that the decree of the said court should be modified, at least in so far as it directed the Circuit Court to dismiss the bill of complaint. The court thereupon granted the prayer of the

said petitioners for a rehearing, and ordered that the cause should be reheard on printed briefs. Such briefs were thereupon filed on behalf of the respective parties. On August 22, 1901, the Circuit Court of Appeals filed an opinion in the following words:

> "A re-argument was granted in this cause because the court deemed it proper to reconsider that part of its former order directing a dismissal of complainants' bill. A majority of the court remain of the opinion that there should be no modification of the order.
>
> "Accordingly a mandate will issue pursuant to the terms of the former order."

A mandate has since gone out to the Circuit Court, directing it to dismiss the bill of complaint with costs.

7. The letters patent in suit relate to the construction of trucks for four-wheel electric street cars. The nature of the invention may best be stated in the language of Judge Shipman in the case (*Brill* vs. *Third Avenue Railroad Co.*) in which he ***sustained the validity*** of the patent now before this court.

> "After electricity was substituted upon city railroads as a motive power to move cars formerly drawn by horses, the railroad corporations were subjected to great expense and the passengers to severe inconvenience in consequence of the oscillation of the cars from end to end, or "galloping" motion as it was called. The horse cars were sixteen feet long and had a wheel base or distance between the two pairs of wheels of six to seven and one-half feet. The new electric cars were from eighteen to twenty-two feet long, but, in consequence of the short radii of curves in city streets where cars turn from street to street, it was necessary to keep the wheel base about as short as before to enable the car to pass around the curves, and, there-

fore, the car body was longer than the truck and overhung it. The result was that these overhanging and unsupported ends oscillated, pounded the rails, strained the trucks and caused discomfort, and, on heavily laden open cars, danger to the passengers. The patentee says in his specification, 'The main object of my invention is to enable a truck of comparatively short wheel-base to be used, and to support a car body upon it, the ends of which overhang the truck for some distance. My invention is also intended to overcome in a measure the end vibration or oscillation of the car body and movable portion of the truck to which the car is secured.'"

This is clearly, in effect, a statement that the object of the invention was to support a long car body on a short wheel-base in such a manner as to provide an improved and more efficient car support, and to overcome end vibration or oscillation.

8. The trucks in use on four-wheel cars prior to the date of this invention had side beams or frames resting on the axle boxes. The car springs were supported on these side beams by *spiral* springs. Resting upon the spiral springs were upper chords or frames, to which the car body was fastened and on which it rested, the two parts being spring-supported. The affidavits show, as just stated in the extract from Judge Shipman's opinion, that this method of spring support was a failure. The cars "oscillated, pounded the rails, strained the trucks and caused discomfort, and, on heavily laden open cars, danger to the passengers." The evidence further shows that this oscillation was so excessive that the speed had to be reduced below the limit of profitable operation. The patent in suit furnished almost a complete remedy. By the combination of elliptical springs with the old spiral springs in their patented relationship, which was entirely new in the art, the *rhythm of the motion* of the oscillating car body was broken and the gallop-

ing or rocking motion was done away with. What the patentee really invented and gave to the art was the knowledge that the combination of spiral and elliptical springs, being springs of different periods of vibration, would, in combination with the stationary and movable frames of the truck of the patent, prevent or lessen oscillation. Experience and the practical use of the truck of the patent on electric railways proved that he was correct; the old spiral spring arrangements went entirely out of use, and the combination of the patent was, as Judge Shipman found, "universally adopted."

9. Claims 1 and 2, which were the only claims in controversy on this motion for a *preliminary injunction* (but *not* the only claims as to which complainants expect to establish infringement at *final hearing*), are as follows:

> "1. In a motor-truck, the combination, with a stationary frame supported upon the running-gear, said frame having sections extending outwardly from the axle, of a movable frame supported upon said truck, spiral springs located between the movable and stationary frames, and elliptical springs located between the extended sections of the said rigid frame and the movable frame substantially as described.
>
> "2. In a truck, a spring-supporting frame supported upon the running-gear by saddles and having sections extending outwardly from the axles, a movable frame having like extensions, spiral springs located between the saddles and movable frame, and elliptical springs located between the spring-supporting frame and the movable frame, substantially as described."

Claim 1 covers the stationary frame (supported on the running gear); the movable frame (on which the car body rests); spiral springs located between these two frames; and elliptical springs located between the *outward extensions* of those frames.

Claim 2 covers the said stationary frame (supported on the running gear by *saddles*); the said movable frame; spiral springs between said saddles and said movable frame; and elliptical springs *between said frames*.

Claim 1 provides that the elliptical springs shall be located between the *outward extensions* of the movable and stationary frames, while claim 2 specifies only that their location shall be *between* said frames.

Judge Shipman held as follows:

> "The *gist* of the invention consisted of combining with the frames of the truck and the spiral springs, another class of springs, viz., elliptical springs, between the car body and the extensions of the independent [stationary] frame. The *elliptical* springs are *slower* in their *action* than the spiral springs and *neutralize the longitudinal oscillation* of the car body."

Other claims of the patent (9, 10, 11 and 14) contain an *additional* feature of the invention not contained in claims 1 and 2. This additional feature is also well expressed by Judge Shipman in the same case in the following words:

> "A *second* and *minor feature* of the invention described in claims 9, 10, 11 and 14 is such an arrangement of the elliptical springs with the car body that they 'will not come into play until after the axle-box springs have begun to compress, and the action of the spiral springs in lifting the car body is continued after the elliptical springs have ceased to act.' The elliptical springs are not depressed until the car body or one end of it has become depressed by the weight of the passengers or some other cause, when this slower motion interposes and checks the continuation or increase of oscillation."

And Judge Shipman further said in the same opinion:

> "It has already appeared that the *gist of the invention* is described in claims 1 and 2.

"The result of the *minor* invention of claims 9, 10, 11 and 14 was important, though upon first inspection its marked importance does not appear, but it perfected the *general* invention of the first two claims."

10. The defendants (the Peckham Company) appear to have manufactured three kinds of trucks, all of which had movable frames, and stationary frames (side beams) supported on the running gear, both of which frames were identical with those of the patent in suit. They also had spiral springs located between said frames, and elliptical springs located between the extended sections of said frames as in claim 1. The said trucks had, in combination with said movable frames and stationary frames (the latter supported on the running gear by *saddles*), spiral springs located between the saddles and the movable frames and elliptical springs located between the said movable and stationary frames as in claim 2.

The defendants' counsel has at all times admitted that if any one of the defendants' trucks infringed, they all did.

The defendants took the ground:

1. That *their* trucks prevented or lessened oscillation *solely* by the use of small underlying tension springs attached to the lower ends of rods which connected the upper and lower frames.

2. While admitting that they used the elliptical springs (of the patent in suit), they set up they that used them solely as braces to steady the spring-supported car on the truck and to prevent it from having a swaying or side-to-side motion, for which purpose they fastened the upper side of their elliptical springs to the lower side of their movable frames.

They argued that, for these reasons, their structures "differed radically both in construction and mode of operation from

that of the patent in suit." They did not, however, pretend to dispute that all three of these trucks contained the invention of claims 1 and 2, if these claims were to be construed as they read and as they were construed by Judge Shipman. And Judge Lacombe, in the Circuit Court, held that the combination which Judge Shipman described as the gist of the invention is undoubtedly in defendants' structure.

3. But they set up that the state of the art as shown by two patents, viz., Manier, No. 409,993, issued August 27, 1889, and Peckham, No. 419,876, issued January 21, 1890 (both of which were fully considered by Judge Shipman), imposed such a limitation upon claims 1 and 2 that the said claims could not be held to cover the defendants' trucks. The defendants, while admitting their use of said stationary and movable frames and the combination of spiral and elliptical springs with said frames, claimed that their spiral and elliptical springs were so arranged that their elliptical springs did not come under compression subsequently to the spiral springs, and therefore they did not infringe upon claims 1 and 2, which they maintained (contrary to Judge Shipman's positive adjudication and to the plain language of said claims), must be limited by the said state of the art and the language of the patent to such subsequent compression of the elliptical springs.

11. The record in the cause showed, as above stated, that the previous suit upon this patent (*Brill* vs. *Third Avenue Railroad Company*, decided July 9, 1900) had been heard by Judge *Shipman*, upon a long and elaborate record. The hearing occupied an entire day, and extensive printed briefs were filed on both sides. The case was elaborately contested at every point by able and experienced counsel. Copies of the record in that case were before the court below as a part of the evidence in the present case. The complainants' affida-

vits in the present case were made by substantially the same persons as testified in the *Third Avenue* case, and covered substantially the same ground. The above-mentioned patents to Manier (409,993) and Peckham (419,876), were set up in that case, were fully considered by the expert witness for the defendants therein, and by Judge *Shipman* in his opinion, and were disposed of by him as not placing any limitation upon any of the claims in the controversy before him. The *Third Avenue* record shows that, in a full and careful opinion, he sustained the validity of claims 1, 2, 9, 10, 11, 12, 14 and 27. In doing so he classified those claims as follows:

Claims 1 and 2 were held by him, as above stated, to cover the *gist of the invention* of the patent, which consisted in combining with the frames of the truck and the spiral springs another class of springs, viz.: elliptical springs, between the upper or movable frames and the extensions of the side beams (which rest on the axle boxes).

Claims 9, 10, 11 and 14 were held by him to constitute a *minor feature* of the invention, viz.: such an arrangement of the elliptical springs that they are not depressed until the car body, or one end of it, has become depressed.

Claims 12 and 27 as sustained by him need not be particularly considered.

This precise classification of the claims and the exact scope of the claims in each class were of the essence of the decision of Judge *Shipman*. It was the principal contention in the case before him and its decision was absolutely essential to the proper adjudication of the issues raised therein. Judge *Shipman* was of opinion that claims 1 and 2 were to be construed broadly in accordance with their terms, and so construed them notwithstanding the Manier and Peckham patents, which were fully considered by him, and which alone are relied upon by the present defendants. He said:

> "The *gist* of the invention consisted in combining with the frames of the truck and the spiral springs, another

class of springs, viz., elliptical springs between the car body and the extensions of the independent frame. The elliptical springs are slower in their action than the spiral springs and neutralize the longitudinal oscillation of the car body. * * * This leading feature of the invention is described in claims 1 and 2, which do not contain the limitations of the invention described in the next paragraph [referring to the successive compression].

"It has already appeared that *the gist of the invention is described in claims 1 and 2.*"

12. The present defendants have never attempted to deny (nor did the Court below deny), that all three of their truck structures infringe upon claims 1 and 2, either—

(1) If these claims are to be construed as they read; or

(2) If they are to be construed as Judge *Shipman* construed them.

It further appeared fully in the *Third Avenue* case (and the same facts substantially are established by practically the same witnesses deposing in the present Record) that prior to the invention of the patent in suit, the use of electric street railway cars with long overhanging ends which were then *necessary* to the successful conduct of the business, was rendered *practically and commercially impossible* by reason of the excessive oscillation of the cars when running at speed, that the invention of the patent in suit afforded a remedy for this oscillation, and that this invention was immediately adopted by the trade, and *was "universally adopted," to the exclusion of all other and earlier devices.* In the opinion in the *Third Avenue* case, on the same state of the art as is now before this court, Judge Shipman said:

"The invention, as a whole, attracted the immediate attention of railway superintendents, *was found to accomplish its object and to be almost a complete remedy*, and

trucks having spiral springs next to the axle boxes and elliptical springs on the extensions of the truck frames, *have been universally adopted.*"

"The necessity for a remedy against the pounding of the car, the importance of the result, the adoption of the invention by experienced railway superintendents, the number of previous attempts at a remedy, and the barrenness of their results, go far to show that the work of an inventive mind was required, and was active in the invention. The testimony of the defendants' expert itself, as he goes through the history of the art, and thereby points out what the patentee's combination did, as compared with previous efforts to do something, show that the patented improvement was patentable."

13. Fortified by this decision of Judge *Shipman* upon a full record, the complainants filed their bill in the present case, in which they aver that the defendants had infringed upon the patent in suit *without limiting this allegation to any particular claims.* The defendants' trucks, as has not been denied, have that combination of spiral and elliptical springs which Judge *Shipman* found to be the *gist* of the complainants' invention and to be covered by claims 1 and 2. Therefore the complainants confined their motion for a *preliminary injunction* to claims 1 and 2, as to the infringement of which it was supposed then (and has never been denied), there could be no doubt, in view of Judge *Shipman's* adjudication. The motion for a preliminary injunction was properly, under the usual and proper practice, supported by proofs of an almost formal character—to the effect that the defendants' devices embodied the invention of claims 1 and 2 as interpreted by Judge *Shipman*, such proof being sufficient to entitle the complainants to a preliminary injunction in the Circuit Court

under the well-settled rule. [1] Relying upon the opinion of Judge *Shipman* in the *Third Avenue* case upon a record containing both the Manier and Peckham patents (alone referred to by the court below in this case as imposing a limitation upon the scope of claims 1 and 2), the complainants in the present case deemed it unnecessary to show by their injunction affidavits that the actual operation of the combined elliptical and spiral springs described and shown in the Brill patent in suit, and those found in the defendants' infringing truck structures, was identical. In so far as there is any evidence in this Record for defendants to the contrary, it consists of *ex parte* affidavits to which, under the practice of the Circuit Court for the Second Circuit, the *complainants were not permitted to reply*, and contains the statements of affiants who have not been subjected to cross-examination, and these affiants were, with one or to minor exceptions, either interested parties or expert witnesses employed by the respondents herein for the purpose of testifying on their behalf.

Proof of the actual operation or action of the springs of the defendants' trucks was immaterial under the construction placed by Judge *Shipman* upon claims 1 and 2, and no such proof therefore was given. But if, upon full proofs, taken in

[1] In the recent case of *Consolidated Fastener Co.* vs. *Hays*, 100 Fed. Rep. 984, 989 (decided February 28, 1900) the Circuit Court of Appeals for the Second Circuit lays down the following principles:

"Shortly after its organization this Court had occasion to enunciate the proposition that, where there was an appeal from an order granting preliminary injunction, the Court below having followed an adjudication at circuit sustaining the patent after contest upon pleadings and proofs, such adjudication is to have the same weight which it should have before the Circuit Court. * * * The propriety of some such rule is apparent. The prior adjudication has been secured by complainant on testimony which has been sifted by cross-examination, and it would seem that he should be entitled to cross-examination of defendant's experts before being deprived of the advantage of his previous decree. Especially so in view of the ease with which *ex parte* affidavits of experts exploiting any theory desired may apparently be obtained. This practice *has been ever since adhered to by this Court.*"

the due course of equity, the complainants fail to show that the Peckham patent, 419,876, does *not* interfere with the construction placed upon claims 1 and 2 by Judge Shipman, your petitioners claim that they have a right in justice to show that claims 1 and 2, even if limited, should receive a less limited interpretation than has been imposed upon them by the Circuit Court of Appeals, and one which will still cover defendants' combination of elliptical and spiral springs with the movable and stationary frames, if it be shown *by proofs* that they operate in the same manner as the combination of such springs in the letters patent in suit, notwithstanding the addition of the tension spring by defendants, upon which they relied as differentiating the defendants' trucks from the truck of the patent in suit.

Even if claims 1 and 2 are held to be subject to a limitation to subsequent compression, your petitioners aver that they can establish by proof:

1. That all defendants' trucks *have* the element of subsequent compression of one set of springs as is found by the court below in these words:

> "In the car trucks of the defendant both sets of springs are brought into action and begin to compress simultaneously *when the weight upon them is greater than the normal weight of the car.*"

That is, *one set* of defendant's springs *take the weight* up to a point and *after that*, and not till then, the other set begins to compress.

(2) That it *makes no difference in practice* as to which set of springs is subsequently compressed;

(3) That the twelve spiral springs of defendants' "Extra Long" truck and the eight spiral springs of their "Excelsior" and "Standard," respectively, are necessarily stronger than the four elliptical springs on those respective trucks, and therefore their spiral springs are their *main* car springs:

(4) That the defendants have advertised that their *spiral* springs are each of greater carrying capacity than each of their elliptical springs, and, therefore, for this reason their spiral springs necessarily constitute their *main* car springs.

14. As above averred, claims 1 and 2 were the only claims in issue on the motion for a *preliminary injunction*, although the bill of complaint avers infringement of the letters patent broadly, covering all the claims. That motion was limited to those claims because it was clear that the trucks which the Peckham Company was advertising in the trade journals and selling, infringed upon those said claims, either as they had been adjudicated by Judge *Shipman*, or as they read. Your petitioners therefor claim a right to be heard upon other claims, the validity of which was established by Judge *Shipman*, and to offer *proofs* at final hearing that such other claims have been infringed upon by the defendants.

The petitioners are advised that the fact that they moved for a preliminary injunction only upon claims 1 and 2 (because the infringement of those claims could most easily be shown from the Peckham Company's advertisements in trade journals) ought not, in justice, to preclude them from proceeding with the cause for the purpose of showing that other claims of the patent have been infringed by the defendants' truck structures. Of this obvious right your petitioners have been entirely deprived by the decree of the court below.

The petitioners therefore claim the right to show by proofs that claims 9, 10, 11 and 14 (sustained by Judge Shipman), and especially claims 9 and 10, are infringed. Of these, claim 9 covers the subsequent compression of either set of springs, which applies to all the defendants' trucks, and claim 10 covers the subsequent compression of the end springs, which applies to their "Standard" and "Extra Long" trucks. The court below, as just stated, has found that all defendants' trucks have the element of subsequent compression.

15. The defendants' evidence as to the construction and mode of operation of the defendants' trucks consists of *ex parte* affidavits which (under the practice in said Circuit Court, relating to motions for preliminary injunction) were not served on complainants' counsel *till the hearing* of the motion for a preliminary injunction and to which complainants (under the same practice) were not permitted to reply by rebutting affidavits. These affidavits purported to give, at great length, the results of certain alleged experiments conducted by the affiants for the purposes of this case, in order to show the mode of operation of the Peckham Company's trucks and were *largely relied upon* by counsel for the purpose of differentiating the defendants' trucks from the truck of the patent in suit. The defendants contended that these experiments established (as stated in their printed argument below), that "the defendant's (Peckham) structures differ radically both in construction and in mode of operation from that of the patent in suit."

The petitioners claim the right to cross-examine the said affiants as to the nature of the said experiments; as to their results; and as to the opinions of the affiants based thereupon and set forth in their said affidavits; and also claim the right to offer *proofs* on their own behalf in denial of the statements of such witnesses.

16. The opinion of the court below, in which it struck down this important and valuable patent already fully sustained by Judge *Shipman*, is based almost entirely upon the Peckham patent, 419,876. The Manier patent, 409,993, though considered by it, was really given no special weight. The Manier patent does *not* show a *combination* of spiral and elliptical springs, but merely an *alternative* use of one or the other class. The court below found that in view of this Peckham patent, and largely of that alone, there was no new mode of operation or new result produced by the Brill combination of

springs. Inasmuch as Judge *Shipman* in the *Third Avenue* case held, in the most emphatic language, that this Peckham patent was irrelevant, and pointed out that the defendant's expert in that case had not even referred to it in his direct examination as one of his "best anticipations," and as Judge *Shipman*, sitting in the same Circuit Court, had sustained claims 1 and 2 broadly *notwithstanding this Peckham patent*, the complainants in this case at bar did not, under the practice of that court on a motion for a preliminary injunction, introduce any evidence as to the working of the device of this Peckham patent. They now claim that they are entitled to proceed in the ordinary course of equity to show by proper evidence that the construction and mode of operation of the truck of this Peckham patent are radically different from those used by Brill and shown in the patent in suit and in the defendant's infringing trucks, *not so much because* Peckham shows a *semi*-elliptical spring, but because there are neither elliptical nor semi-elliptical springs in the Peckham patent *located between extended sections of the upper chords and the side beams to support the car body at each of its four corners;* but on the contrary each of the two semi-elliptical springs in this Peckham patent is carried across the truck *transversely*, so that these semi-elliptical springs are in contact at their middle point (which point is also in the *longitudinal center line of the truck*) with a supplementary transverse truss at the front and rear ends of the car body, and the ends of the semi-elliptical springs play *loosely* in shoes on the side beams. The combination of claims 1 and 2 of the patent in suit is therefore in no way present in, or suggested by, this Peckham patent.

The petitioners claim also that they are entitled to show further that this Peckham patent is a mere paper patent; that it was taken out by one of the defendants (Peckham) in connection with the business of the defendant Peckham Company, or its predecessor in the business;

that not a single truck has ever been made or used in accordance with it; and that, on the contrary, the defendant Peckham corporation, in all three types of trucks here complained of as infringements, combines with spiral springs four full elliptical springs *located between the extended sections of the sides* of the upper chords and the side beams, *precisely as in the Brill patent in suit;* and neither Peckham nor the Peckham Company, defendants, nor the predecessor Peckham corporation, with both of which corporations he has been continuously connected, have ever used the *transverse* semi-elliptical spring of this Peckham patent.

Your petitioners also claim that they are entitled to show by practical testimony that there is a vital difference between the location of the elliptical springs of the complainants' and defendants' trucks, on the one hand, and the location of the semi-elliptical spring of this Peckham patent on the other hand, and that not only had Peckham, in this patent, no notion of the utility of combining the elliptical and spiral springs *as in the Brill patent in suit*, but also that the construction shown in that Peckham patent was not practical or *capable* of actual use in the business. Also, they are entitled to show other features which distinguish the construction of this Peckham patent from that of the Brill patent, and that it has not even the elements of the claims of the patent separately considered. For example, in the Brill patent, as in the defendants' infringing trucks, the side beams or "stationary frames" are mounted upon the axle-box saddles. As Judge Shipman said:

> "In the patented structure, a pair of *rigid* longitudinal side beams, which derive their support from the axle-boxes, extend lengthwise of the truck beyond the wheels at each end."

On the other hand, the Peckham patent shows the side beams pivotally connected with and swinging below the axle-

boxes so as to be able to swing back and forth longitudinally —a perfectly useless construction which has never been used at all and one which would destroy the efficiency of all the springs connected therewith, and there are other important practical differences. In fact, the truck of the Peckham patent *is an entirely different structure*, as well as of no practical use, and never has been put into practice.

An electric car truck is a structure, the practical utility of which can be ascertained only by actual experiment under the usual conditions of electric railway practice. Loaded with many tons weight of car body and passengers and motors; run at high speed; requiring to be so constructed that the motor can be properly and efficiently mounted on it, actual use and experience alone, and not mere inspection of a paper truck are the only test of practical utility. Your petitioners submit that they should not be *deprived of the substance of their patent* until they at least have an opportunity to offer proof in relation to this Peckham patent, and to cross-examine the defendants' witnesses if they attempt to controvert this proof. Such proof was not required in the *Third Avenue* case, because the testimony for the defendants therein did not seriously urge that this Peckham patent anticipated the Brill patent. And it was not seriously considered by the Circuit Court of Appeals at the argument, the Court then stating to counsel, in effect, that it was not of importance and that no argument need be made upon it (or upon the Manier patent).

17. Your petitioners further show that they were not adequately heard by either the Circuit Court or the Circuit Court of Appeals. In the former court at the hearing on the motion for a preliminary injunction, the defendants' affidavits were (under the practice of that court) filed at bar and were never previously thereto served upon or exhibited to the com-

plainants' counsel; and, under the same practice, the complainants were not permitted to reply thereto by counter-affidavits. In the Circuit Court of Appeals (under the practice of that court) but an hour was given to counsel for the present petitioners (then appellees), of which, after the necessary opening of the mere facts of the case by one of the appellees' counsel, not fifteen minutes remained for argument by the other counsel upon the real questions involved.

Your petitioners submit that if every appeal on the granting of a preliminary injunction is to be, or may become, a final hearing of the cause, rules of court or practice which provide for the hearing of such motions without requiring the defendant to serve his affidavits upon the complainant prior to the hearing, and which do not permit the complainant to file rebuttal affidavits; and which, on appeal, restrict the argument of counsel for complainant in an important case to one hour, may well lead to a denial of justice. The hardship is especially great in the case at bar where the undisputed evidence is that the patent is a most meritorious one and is one which, as Judge Shipman has found, in a most important art, was almost a complete remedy for a serious evil, and had been "universally adopted" in the street railway business, a business of enormous importance and magnitude. And in this important business it is obvious that the truck or running gear which sustains the great weight of the car and passengers; carries the heavy motors and their gearing; and, generally, stands the brunt of the work, is the most important element. This record shows that, until the Brill patent, four-wheel electric railway cars (*and they were the only kind then in use*) could not, on account of oscillation, be run fast enough to accomplish a commercial success.

18. Your petitioners are advised that the decree directing the bill to be dismissed, made upon a record in which the complainants had not been permitted to offer rebutting affi-

davits, was, under the circumstances of this case, contrary to the due course of proceedings in equity and deprived the complainants of valuable property contrary to law.

19. The Record in this cause contains affidavits on behalf of the complainants which show that the patentee fully conceived and completed the invention of the patent in suit as early as May, 1889. This was *prior to the date of both the Manier and Peckham patents*, relying upon which patents the court below dismissed the bill of complaint. These patents were dated as follows:

Manier, August 27, 1889.

Peckham, January 21, 1890.

If the above date of the conception of the invention of the patent in suit be established, your petitioners are advised that these two patents (Manier and Peckham) are irrelevant to the issue. The evidence was not considered of importance by Judge Shipman for the reason that he considered that neither of these patents imposed any limitations upon claims 1 and 2.

20. Your petitioners submit that it would be an intolerable hardship and injustice to them if they should be finally deprived of the opportunity to present testimony on their own behalf and also to cross-examine the defendants' witnesses upon the following issues, among others, namely:

I. The actual construction of the defendants' various trucks as they have made and sold them from the time they began to manufacture trucks containing the combination of spiral and elliptical springs of the patent in suit.

II. The actual operation of the defendants' devices as compared with the devices of the patent in suit.

III. The question whether defendants' devices do, *in fact*, infringe claims 1 and 2, if said claims are to be limited as held by the Court below.

IV. The question whether defendants' trucks do, *in fact*, infringe other claims of the patent in suit (e. g. claims 9, 10, 11 and 14, which have been sustained by Judge *Shipman*).

V. The question how the devices of the Peckham patent, No. 419,876, would operate, if used, and whether they necessarily limit the complainants' patent in the manner adjudged by the Circuit Court of Appeals.

VI. That the devices of the said Peckham patent were and are, *in fact*, incapable of practical use, and that they were never in fact used.

VII. The question whether the complainants' invention antedates the said Peckham and Manier patents.

VIII. The utility and value, as well as the wide adoption and use, of the combination of claims 1 and 2 of the patent in suit, consisting essentially of spiral and elliptical springs combined with the side beams and movable frames of a car truck, the said elliptical springs being of slower action and of a different period of action from the spiral springs, as showing patentable quality in the invention, regardless of the relative times at which one spring or the other comes into use.

IX. That the defendants' trucks are *not*, as claimed by the counsel for defendants, the Peckham Company, in his argument against the petition for re-hearing in the court below, "radically different, both in construction and mode of operation from that of the patent in suit," such allegation being based upon *ex parte* affidavits relating chiefly to certain alleged experiments conducted by witnesses for the very purpose of this case, to which affidavits your petitioners were not permitted to reply in the Record now before the Court.

21. Your petitioners are advised that the ruling of this Honorable Court in the case of *Mast, Foos & Co.* vs. *Stover Manf'g Co.*, 177 U. S. 485, is not an authority for the action of the court below in decreeing the dismissal of the Bill of Complaint; that the said ruling was, by the language in the opinion

of this court, limited to cases in which the entire merits of the case are before the court, on undisputed and indisputable facts, without "suggestion of further proofs" on any part of the case; and that the circumstances of the case at the bar as stated in this petition, place the case entirely outside of the operation of the said ruling.

22. The decision of the Circuit Court of Appeals is of vital and far-reaching importance in the administration of the law in all the circuits of the Federal judiciary. Its importance goes far beyond the decision upon the particular case, and affects, or may affect, numerous future cases of motions for preliminary injunctions on patents. It relates to a rule of practice—*administrative* law— of much wider applicability than mere cases of *substantive* law, in which only the rights of the actual litigants are concerned.

If, as your petitioners are advised, the court below has misunderstood the scope of the ruling in the Mast, Foos & Company case and has applied it to a state of facts never contemplated by the decision of this court in that case, your petitioners submit that the interests of justice require that this court shall, by its authoritative ruling, define the limitations which it places upon the application of the doctrine of that case, to the end that in the numerous cases which may arise, the Circuit Courts of Appeals shall not extend the doctrine beyond its proper and just scope.

23. And if it appear to this Court that "sufficient weight" was not, under the circumstances, given by the court below to the Rule of Comity, your petitioners submit that the error of the Court below should be corrected, under the supervising jurisdiction of this Court.

Wherefore, in view of the premises, the petitioners pray that this Honorable Court will grant its writ of *certiorari* directed to the Circuit Court of Appeals for the Second Cir-

cuit, requiring that the record of said cause in the said court be certified to this court, and that this Honorable Court will thereupon proceed to correct the errors complained of, reverse the said decree and remand the said cause with directions to affirm the decree of the said Circuit Court awarding an injunction, and to direct the said Circuit Court to permit the cause to proceed to final hearing in accordance with the due course of equity, and will give to your petitioners such other and further relief as the nature of the case may require, and to the court may seem proper in the premises.

FRANCIS RAWLE,
for Petitioners.

FREDERICK P. FISH,
Of Counsel.

STATE OF PENNSYLVANIA, }
COUNTY OF PHILADELPHIA, } *ss.*

Before the undersigned, a notary public, personally comes JOHN A. BRILL, who, being duly sworn, deposes and says that the matters stated in the foregoing petition for a writ of *certiorari* are true as therein set forth, to the best of his knowledge, information, and belief.

JNO. A. BRILL.

Sworn and subscribed to before me this Twenty-fourth day of October, A. D. 1901.

HENRY C. ESLING,
Notary Public.

[SEAL.]

Commission expires January 20, 1903.